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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/538,879

06/14/2005

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7217/71169

8796

530 7590 11/25/2008  
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EXAMINER

MCINTYRE, CHARLES AARON

ART UNIT

PAPER NUMBER

3621

MAIL DATE

DELIVERY MODE

11/25/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/538,879	<b>Applicant(s)</b> NAKAMURA ET AL.	
	<b>Examiner</b> C. Aaron McIntyre	<b>Art Unit</b> 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 12-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☒ Claim(s) 2 and 9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>20061117 and 20050614</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Acknowledgements***

1. Claims 1-29 are pending in this application.
2. Claims 12-29 are hereby withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a non-elected invention, there being no allowable generic or linking claim.
3. Claims 1-11 have been examined.

### ***Information Disclosure Statements***

4. The Japanese patents cited in Applicant's information disclosure statements were reviewed initially through Derwent (abstract only) and then additionally via machine translation unless there was an English patent family member.

### ***Restrictions***

5. Restriction is required under 35 U.S.C. 121 and 372.
6. This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.
7. In accordance with 37 CFR 1.499, Applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-11, drawn to an apparatus having one or more functions on which use limitations can be imposed, classified in class 705, subclass 51.

Group II, claims 12-26, drawn to a method for controlling a use of one or more functions of an apparatus, classified in class 705, subclass 59.

Group III, claims 27-29, drawn to a server with a key generating means along with an electronic apparatus, classified in class 705, subclass 56.

8. Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the method of Invention II can be practiced using a materially different apparatus such as by using a secondary source for use permissions.

9. Inventions II and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the method of Invention II can be practiced using a materially different apparatus such as by using a secondary source for the use-permitting keys.

10. Inventions III and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as

claimed because the servers have separate utility such as providing keys for other electronic apparatus's beyond the electronic apparatus of the combination.. The subcombination has separate utility such as using a key derived from another materially distinct server.

11. Examiner has required restriction between combination and subcombination inventions. Where Applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

12. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);

(d) the prior art applicable to one invention would not likely be applicable to another invention;

(e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. §101 and/or 35 U.S.C. §112, first paragraph.

13. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 C.F.R. §1.143) and (ii) identification of the claims encompassing the elected invention.

14. The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 C.F.R. §1.144. If claims are added after the election, Applicant must indicate which of these claims are readable on the elected invention.

15. If claims are added after the election, Applicant must indicate which of these claims are readable upon the elected invention.

16. Should Applicant traverse on the ground that the inventions are not patentably distinct, Applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if Examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. §103(a) of the other invention.

17. During a telephone conversation with Mr. Dennis M. Smid (Reg. No. 34,930), attorney for Applicant, on November 7, 2008 a provisional election was made without traverse to prosecute Invention I, claims 1-11. Affirmation of this election must be made by Applicant in replying to this Office action. Claims 12-26 are withdrawn from further consideration by Examiner, 37 C.F.R. §1.142(b), as being drawn to a non-elected invention.

18. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. §1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 C.F.R. §1.48(b) and by the fee required under 37 C.F.R. §1.17(i).

### ***Specification***

19. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 C.F.R. §1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

- a. The “storage means for storing” as recited in claims 1, 3, 8, and 10.
- b. The “limiting means for storing” as recited in claim 1.
- c. The “limiting means ... for referencing” as recited in claim 1.
- d. The “controlling means for storing” as recited in claim 8.
- e. The “receiving means for receiving” as recited in claims 7 and 8.
- f. The “transmitting means for transmitting” as recited in claim 8.

***Claim Objections***

20. Claims 2 and 9 are objected to because of the following informalities: Claim 2 recites the limitation "number of days or times of use allowed for use or a time period allowed for use" which would be difficult for a person having ordinary skill in the art to properly interpret.

21. For the purposes of compact prosecution, Examiner is interpreting the claims to be limited to (1) a day limit, (2) number of uses limit, or (3) a time period limit.

*a. Examiner Note: Additionally, the time period use is never stored in claims 3 and 10 while the other two limitations are subsequently stored.*

22. Appropriate correction or clarification is required.

***Claim Rejections - 35 USC § 101***

23. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

24. Claims 1-5 and 7-10 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

25. Claims 1-5 and 7-10 are drawn to a computer program per se. Computer programs per se intrinsically require no tangible physical structure, thus do not constitute tangible physical articles or other forms of matter. Therefore, computer programs per se are not considered to be statutory subject matter. To be statutory, a computer program must be: (1) coupled with or combined with some statutory physical structure, and, (2) produce or effect some useful, concrete, and tangible result. See MPEP § 2106.01.



- a. Regarding claims 1 and 8, the phrase “function executing unit” could be software as evidenced by it being distinguished from a CPU with the setting information being “rewritten by the controlling means, such as CPU, so that the function(s) may be carried out subsequently by the function executing unit.” *See Applicant’s Specification [0019]*.
  - b. Regarding claims 1 and 8, the phrase “storage means for storing” could be anything, including software such as a database. The specification is silent regarding whether or not this is software.
  - c. Regarding claim 1, the phrase “limiting means for storing” is most likely software and the specification does not disclose any limiting means that is not software.
  - d. Regarding claim 8, the phrases “transmitting means for transmitting” and “receiving means for receiving” could be software and the specification is silent regarding whether or not these limitations are software.
  - e. Regarding claim 8, the phrase “controlling means for storing” could be software as evidenced by conflicting controlling means in the specification such as “controlling means, such as CPU” [0019] and “controlling means for rewriting the setting information for extending the possible use range of the function(s)” [0016], the latter of which could be software.
26. Further evidence that all of the above could be software per se can be found in Applicant’s abstract which states “variety of functions are loaded on the electronic apparatus by hardware circuitry **or** by computer programs.” *See Applicant’s specification [abstract]*.
27. Regarding claims 6 and 11, it is Examiner’s position that an “infrared light receiving unit” must be hardware.

***Claim Rejections - 35 USC § 112, second paragraph***

28. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

29. Claims 1-11 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

a. Claims 1, 3, 7, 8, 10, and 11 are indefinite because they recite one of the following limitations that would be unclear to a person having ordinary skill in the art because there is no definitive corresponding structure present in the specification, such as:

- i. “function executing unit” could be hardware or software.
- ii. "storage means for storing" could be anything.
- iii. “limiting means for storing” may not necessarily be software.
- iv. "controlling means" could be hardware or software.
- v. “receiving means" could be hardware or software.
- vi. “transmitting means” could be hardware or software.
- vii. the limitation in claim 1 “means, and for" which may refer to a second limiting means.

b. Claims 2-3 and 9 are indefinite because it recites the limitation “times of use" which is not clear to a person having ordinary skill in the art whether this refers to a limit on the number of uses or a limit on the actual clock time such as 8 AM to 5 PM.

- c. Claim 3 is indefinite because it recites the limitation "said controlling means" and there is insufficient antecedent basis for this limitation in the claim.

30. *Examiner Note: The software vs. hardware possibilities are just a clear example of the indefiniteness (meaning they are likely indefinite on other grounds as well). The recited limitations need to be sufficiently definite to one of ordinary skill in the art such that one of ordinary skill in the art does not have to guess as to what Applicant regards as their invention.*

***Claim Rejections - 35 USC § 102***

31. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**32. Claims 1-2 and 4, as best understood by Examiner, are rejected under 35**

**U.S.C. 102(e) as being anticipated by Nakamura et al., hereinafter referred to as**

**Nakamura.**

33. Regarding **claim 1**, Nakamura discloses an electronic apparatus ([fig. 3]) having one or more functions (“*functions*” [fig. 3]) on which use limitations (“*trial periods*” [fig. 7]) can be imposed (“*if you agree, press [ok]*” fig. 7)), comprising

a function executing unit (“*system*” [col. 2, ll. 26-34]) for executing said one or more functions (“*system ... provides the target functions*” [col. 2, ll. 26-34]);

storage means (“*storage section*” [fig. 1]) for storing the contents of use limitations (“*1 Month*” or “*40 days*” [fig. 7]; “*period is set by the management program*” [col. 6, ll. 37-54]) for said one or more functions (“*functions*” [col. 2, ll. 26-34]); and

limiting means (“*management program*” [fig. 1]) for storing the contents of use limitations (“*period is set by the management program*” [col. 6, ll. 37-54]) for said one or more functions, derived (“*arranged*” [col. 6, ll. 37-54]) from input use-permitting key information (“*period may be arranged to vary in accordance with the type of an electronic key inputted*” [col. 6, ll. 37-54]), in said storage means (“*storage section*” [fig. 1]) and for referencing the contents of use limitations (“*1 Month*” or “*40 days*” [fig. 7]; “*period is set by the management program*” [col. 6, ll. 37-54]) stored in said storage means (“*storage section*” [fig. 1]) to limit a function execution (“*Is there any function [a]vailable for trial? - S18*” [fig. 10]) in said function executing unit (“*system*” [col. 2, ll. 26-34]).

34. Regarding **claim 2**, Nakamura discloses wherein the contents of use limitations for said functions are a number of days (“*40 days*” [fig. 7]) or times of use allowed for use (“*predetermined number of times*” [col. 9, ll. 1-25]) or a time period allowed for use (“*predetermined duration of time*” [col. 11, ll. 59-67]).

35. Regarding **claim 4**, Nakamura discloses an operating input unit for inputting said use-permitting key information (“*Input a Function Release Electronic Key*” [fig. 8(a)]; [fig. 4(a)-4(b)]) supplied from a source of use permission (“*electronic key thus issued*” [col. 5, ll. 19-33]).

### ***Claim Rejections - 35 USC § 103***

36. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**37. Claim 3, as best understood by Examiner, is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura.**

38. Regarding **claim 3**, Nakamura discloses a storage means for storing the number of days or times said one or more functions has been used (“*number of use according to a use status*” [col. 14, ll. 34-40]) in said function executing unit (“*system*” [col. 2, ll. 26-34]);

said controlling means (“*control section*” [col. 2, ll. 8-18]) when requested to execute the said one or more functions (“*FIG. 12 ... flow of the process ... function of the subprogram P20 is used*” [col. 8, ll. 39-63]) in said function executing unit (“*system*” [col. 2, ll. 26-34]) referencing the contents of use limitations (“*control section 22 checks whether it is within a trial period*” [col. 8, ll. 64-67 – col. 9, ll. 1-24]; Step S43 [fig. 12]) stored in said storage means and said

number of days or times of use stored in said storage means (“*examining whether or not the number of use of trial reached a predetermined number of times*” [col. 8, ll. 64-67 – col. 9, ll. 1-24]) to control the function execution (“*thereby terminating the process*” [col. 8, ll. 64-67 – col. 9, ll. 1-24]) in said function executing unit (“*system*” [col. 2, ll. 26-34]).

39. But Nakamura does not explicitly disclose that the second storage means is distinct from the first storage means.

40. However, it is old and well known in the art that if two sets of data can be stored in one storage device, the second set of data can alternatively be stored in a second storage device, and Official Notice to this effect is hereby taken.

41. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Nakamura so as to have included a second storage means, in accordance with the teaching of the Official Notice, in order to provide a separate storage location in order to allow data to be manipulated separately without the chance of manipulating the first set of data, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

**42. Claims 5 and 7-10, as best understood by Examiner, are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura in view of U.S. Patent No. 6,223,166 to Kay.**

43. Regarding **claim 5**, Nakamura discloses a scanner ([fig. 1]), but Nakamura does not explicitly disclose a bar code readout unit for reading said use-permitting key information, printed as a bar code, supplied from a source of use permission.

44. However, Kay teaches a similar system, which system of Kay indeed teaches a bar code readout unit (“*portable scanner*” [col. 4, ll. 29-41]) for reading said use-permitting key information (“*scan the ticket bar code for authentication*” [col. 4, ll. 29-41]), printed as a bar code (“*bar code*” [col. 4, ll. 29-41]), supplied from a source of use permission (“*Ticket Server*” [fig. 1]).

45. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Nakamura so as to have included a bar code readout unit for reading said use-permitting key information, printed as a bar code, supplied from a source of use permission, in accordance with the teaching of Kay, in order to provide an easily transportable hard copy ticket containing the use-permitting key information for added convenience, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

46. Regarding **claim 7**, Nakamura discloses receiving means (“*input a function release electronic key*” [fig. 4(a)]) for receiving said use-permitting key information (“*electronic key*” [fig. 4(a)]) from a source of use permission (“*service center, etc., issues a predetermined electronic key*” [col. 5, ll. 19-33]).

47. But Nakamura does not explicitly disclose that this information is transmitted over a network

48. However, Kay teaches a similar system, which system of Kay indeed teaches transmitting information over a network (“*electronic tickets are transmitted over the network 16 to the user station*” [col. 4, ll. 29-41][fig. 1]).

49. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Nakamura so as to have included transmitting information over a network, in accordance with the teaching of Kay, in order to provide increased accessibility by using a network to receive the electronic ticket from a centralized location, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

50. Regarding **claim 8**, Nakamura discloses an electronic apparatus ([fig. 3]) having one or more functions (“*functions*” [fig. 3]) on which use limitations (“*trial periods*” [fig. 7]) can be imposed (“*if you agree, press [ok]*” fig. 7)), comprising

a function executing unit (“*system*” [col. 2, ll. 26-34]) for executing said one or more functions (“*system ... provides the target functions*” [col. 2, ll. 26-34]);

storage means (“*storage section*” [fig. 1]) for storing the contents of use limitations (“*1 Month*” or “*40 days*” [fig. 7]; “*period is set by the management program*” [col. 6, ll. 37-54]) for said one or more functions (“*functions*” [col. 2, ll. 26-34]);

controlling means (“*control section*” [col. 2, ll. 8-18]) for storing (“*storage section*” [fig. 1]) the contents of use limitations (“*1 Month*” or “*40 days*” [fig. 7]; “*period is set by the management program*” [col. 6, ll. 37-54]) for said one or more functions (“*functions*” [col. 2, ll. 26-34]), derived from input use-permitting key information, and for referencing the contents of



use limitations (“*FIG. 12 ... flow of the process ... function of the subprogram P20 is used*” [col. 8, ll. 39-63]; “*control section 22 checks whether it is within a trial period*” [col. 8, ll. 64-67 – col. 9, ll. 1-24]; *Step S43* [fig. 12]) stored in said storage means (“*storage section*” [fig. 1]) to limit function execution (“*thereby terminating the process*” [col. 8, ll. 64-67 – col. 9, ll. 1-24]) in said function executing unit (“*system*” [col. 2, ll. 26-34]); and

receiving means (“*input a function release electronic key*” [fig. 4(a)]) for receiving the use-permitting key information (“*electronic key*” [fig. 4(a)]) from a [source] (“*service center, etc., issues a predetermined electronic key*” [col. 5, ll. 19-33]) responsive to said request for using the electronic apparatus (“*user ... desires any of the functions, he/she can request ... In response to this request, the service center, etc., issues a predetermined electronic key*” [col. 5, ll. 19-33]).

51. But Nakamura does not explicitly disclose:

transmitting means for transmitting apparatus identifying information for identifying the electronic apparatus and a request for permission for using the electronic apparatus over a network to a server of a source of use permission;

received information is transmitted over a network from a server responsive to said request for using the electronic apparatus;

52. However, Kay teaches a similar system, which system of Kay indeed teaches:

transmitting means (“*electronic tickets are transmitted*” [col. 4, ll. 29-41]; [fig. 1]) for transmitting [event] identifying information (“*selects a ticket for purchase to an event*” [abstract]) for identifying the [event] (“*code is compared against the event description*” [abstract]) and a request for permission for using the [event] (“*ticket is accepted for admission to*

*the event*” [abstract]) over a network (“*electronically linked*” [col. 3, ll. 27-48]) to a server (“*to a web site 18*” [col. 3, ll. 27-48]; [fig. 1]) of a source of use permission (“*for selection and purchase by an operator of the remote user station*” [col. 3, ll. 27-48]);

received information (“*electronic ticket*” [fig. 1]) is transmitted over a network from a server (“*electronic tickets are transmitted over the network 16 to the user station*” [col. 4, ll. 29-41]; “*ticket server*” [fig. 1]) responsive to said request for using the [event] (“*ticket is accepted for admission to the event*” [abstract]).

53. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Nakamura so as to have included transmitting means for transmitting apparatus identifying information for identifying the electronic apparatus and a request for permission for using the electronic apparatus over a network to a server of a source of use permission; received information is transmitted over a network from a server responsive to said request for using the electronic apparatus, in accordance with the teaching of Kay, in order to provide increased accessibility by using a network to request and receive the electronic ticket from a centralized location, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

54. Regarding **claim 9**, Nakamura discloses wherein the contents of use limitations for said one or more functions are a number of days (“*40 days*” [fig. 7]) or times of use allowed for use (“*predetermined number of times*” [col. 9, ll. 1-25]) or a time period allowed for use (“*predetermined duration of time*” [col. 11, ll. 59-67]).

55. Regarding **claim 10**, Nakamura discloses a storage means for storing the number of days or times said one or more functions has been used (“*number of use according to a use status*” [col. 14, ll. 34-40]) in said function executing unit (“*system*” [col. 2, ll. 26-34]);

said controlling means (“*control section*” [col. 2, ll. 8-18]) when requested to execute the said one or more functions (“*FIG. 12 ... flow of the process ... function of the subprogram P20 is used*” [col. 8, ll. 39-63]) in said function executing unit (“*system*” [col. 2, ll. 26-34]) referencing the contents of use limitations (“*control section 22 checks whether it is within a trial period*” [col. 8, ll. 64-67 – col. 9, ll. 1-24]; *Step S43* [fig. 12]) stored in said storage means and said number of days or times of use stored in said storage means (“*examining whether or not the number of use of trial reached a predetermined number of times*” [col. 8, ll. 64-67 – col. 9, ll. 1-24]) to control the function execution (“*thereby terminating the process*” [col. 8, ll. 64-67 – col. 9, ll. 1-24]) in said function executing unit (“*system*” [col. 2, ll. 26-34]).

56. But Nakamura does not explicitly disclose that the second storage means is distinct from the first storage means.

57. However, it is old and well known in the art that if two sets of data can be stored in one storage device, the second set of data can alternatively be stored in a second storage device, and Official Notice to this effect is hereby taken.

58. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Nakamura so as to have included a second storage means, in accordance with the teaching of the Official Notice, in order to provide a separate storage location in order to allow data to be manipulated separately without the chance of manipulating the first set of data, since so doing could be performed readily and easily by any

person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

**59. Claim 6, as best understood by Examiner, is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura in view of U.S. Patent No. 6,542,870 to Matsumoto.**

60. Regarding **claim 6**, Nakamura discloses a receiving unit (“*input a function release electronic key*” [fig. 4(a)]) for receiving said use-permitting key information (“*electronic key*” [fig. 4(a)]), acquired from a source of use permission (“*service center, etc., issues a predetermined electronic key*” [col. 5, ll. 19-33]), said use-permitting key information being to the electronic apparatus (“*input a function release electronic key*” [fig. 4(a)]).

61. But Nakamura does not explicitly disclose an infrared light receiving unit for receiving information acquired by wireless communication by a mobile terminal having a wireless communication function and an infrared ray communication function, said information being transmitted by infrared communication.

62. However, Matsumoto teaches a similar system, which system of Matsumoto indeed includes an infrared light receiving unit (“*light receiving unit – 21*” and “*infrared-ray I/F driver – 22*” [fig. 3]) for receiving information (“*information to the light receiving unit 21*” [col. 7, ll. 51-55]) acquired by wireless communication (“*infrared ray signal*” [col. 7, ll. 51-55]) by a mobile terminal (“*remote commander*” [fig. 3]) having a wireless communication function (“*infrared ray signal*” [col. 7, ll. 51-55]) and an infrared ray communication function (“*infrared*

*ray signal*” [col. 7, ll. 51-55]), said information being transmitted by infrared communication (“*infrared ray signal*” [col. 7, ll. 51-55]).

63. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Nakamura so as to have included an infrared light receiving unit for receiving information acquired by wireless communication by a mobile terminal having a wireless communication function and an infrared ray communication function, said information being transmitted by infrared communication, in accordance with the teaching of Matsumoto, in order to increase convenience and mobility by providing a wireless device capable of performing the functions, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

**64. Claim 11, as best understood by Examiner, is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura in view of Kay in further view of Matsumoto.**

65. Nakamura discloses an electronic apparatus having one or more functions on which use limitations can be imposed, as applied in the above rejection of claim 8 under 35 U.S.C. 103(a).

66. Regarding **claim 11**, Nakamura discloses a receiving means (“*input a function release electronic key*” [fig. 4(a)]), and wherein said electronic apparatus includes receiving said use-permitting key information (“*input a function release electronic key*” [fig. 4(a)]) acquired from a source of use permission (“*service center, etc., issues a predetermined electronic key*” [col. 5, ll. 19-33]).

67. But Nakamura does not disclose a transmitting means and a mobile terminal having a wireless communication function and an infrared ray communication function, and an infrared light receiving unit for receiving information, wherein information is acquired by said mobile terminal by wireless transmission and transmitted by infrared communication.

68. However, Matsumoto teaches a similar system, which system of Matsumoto indeed includes a transmitting means ("*Transmission Line – 3*" [fig. 1]) and a mobile terminal ("*remote commander – 91*" [fig. 3]) having a wireless communication function ("*infrared ray signal*" [col. 7, ll. 51-55]) and an infrared ray communication function ("*infrared ray signal*" [col. 7, ll. 51-55]), and an infrared light receiving unit ("*light receiving unit – 21*" and "*infrared-ray I/F driver – 22*" [fig. 3]) for receiving information ("*information to the light receiving unit 21*" [col. 7, ll. 51-55]), wherein information is acquired by said mobile terminal ("*remote commander*" [fig. 3]) by wireless transmission ("*infrared ray signal*" [col. 7, ll. 51-55]) and transmitted by infrared communication ("*infrared ray signal*" [col. 7, ll. 51-55]).

69. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Nakamura so as to have included an infrared light receiving unit for receiving information acquired by wireless communication by a mobile terminal having a wireless communication function and an infrared ray communication function, said information being transmitted by infrared communication, in accordance with the teaching of Matsumoto, in order to increase convenience and mobility by providing a wireless device capable of performing the functions, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

***35 USC § 112 6<sup>th</sup> Paragraph***

**Means Phrase #1**

**Invocation:**

70. It is Examiner's position that in claims 1, 3, 8, and 10, the phrase “storage means for storing” (“Means Phrase # 1”) is an attempt by Applicant to invoke 35 U.S.C. 112 6<sup>th</sup> paragraph. If Applicant disagrees, Examiner respectfully requests Applicant to either amend the claim to remove all instances of “means for” from the claim, or to explicitly state on the record (and supply arguments in support thereof) why 35 U.S.C. 112 6<sup>th</sup> paragraph should not be invoked.

**Invocation Step 1:**

71. First, in accordance with the MPEP §2181, *the Supplemental Examination Guidelines for Determining the Applicability of 35 USC 112 6<sup>th</sup>* (“Guidelines”)<sup>1</sup>, and *Al-Site Corp. v. VSI International Inc.*, 174 F.3d 1308, 1318, 50 USPQ2d 1161, 1166 (Fed. Cir. 1999),<sup>2</sup> Applicant's use of “means for” in claims 1, 3, 8, and 10 create a rebuttable presumption that tends to invoke 35 U.S.C. 112 6<sup>th</sup> paragraph. If the word “means” appears in a claim element in combination with a function, it is presumed to be a means-plus-function element in which 35 U.S.C. 112 6<sup>th</sup> paragraph applies.<sup>3</sup> Since “means for” is recited in Means Phrase #1, this step is clearly met.

**Invocation - Step 2:**

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<sup>1</sup> Federal Register Vol. 65, No. 120, June 21, 2000

<sup>2</sup> See also *Sage Prods., Inc. v. Devon Industry, Inc.*, 123 F.3d 1420, 1427, 44 USPQ2d 1103, 1109 (Fed. Cir. 1997); *Greenberg v. Ethicon Endo-Surgery, Inc.*, 91 F.3d 1580, 1583, 39 USPQ2d 1783, 1785 (Fed. Cir. 1996).

72. Second, in accordance with MPEP §2181, the Guidelines, and *Budde v. Harley-Davidson, Inc.*, 250 F.3d 1369, 1376, 58 USPQ2d 1801, 1806 (Fed. Cir. 2001), it is Examiner's position that Applicant recites a corresponding function to the means—"for storing..."

73. Examiner notes that when determining the function recited "[u]nless something in the written description suggests that the patentee intended the unambiguous language to be construed in a manner inconsistent with its ordinary meaning, we are bound by that language." *Telemac Cellular Corp. v. Topp Telecom Inc.*, 58 USPQ2d 1545, 1550 (Fed. Cir. 2001). Here, the function as found in the Means Phrase # 1 will have its ordinary meaning.

### **Invocation - Step 3:**

74. Third, in accordance with MPEP §2181, the Guidelines, and *Personalized Media Communications, LLC v. International Trade Commission*, 161 F.3d 696, 704, 48 USPQ2d 1880, 1887 (Fed. Cir. 1998), the means-plus-function clause must not recite sufficient definite structure for performing that function.

75. In this case, Means Phrase # 1 does not recite the structural elements which perform the function. In determining whether the presumption of invocation is rebutted, "the focus remains on whether the claim ... recites sufficiently definite structure." *Id.* Furthermore, sufficient structure does not require an exhaustive recitation--only structure to perform entirely the claimed function. *Rodime PLC v. Seagate Technology Inc.*, 174 F.3d 1294, 1304, 50 USPQ2d 1429, 1436 (Fed. Cir. 1999). The "storing the contents..." or "storing the number..." can not be entirely performed by the little if any recited structure in the claim.

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<sup>3</sup> *Id.*



76. Because of the above, it is Examiner's position that Means Phrase #1 invokes 35 U.S.C. 112 6<sup>th</sup> paragraph.

***Corresponding Structure, Material, or Acts***

77. In accordance with MPEP §2181, the Guidelines (section “II”) and *Medtronic*, 248 F.3d at 1311, 58 USPQ2d at 1614, “The next step is to determine the corresponding structure described in the specification and equivalents thereof. Structure disclosed in the specification is 'corresponding' structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim.” *Id.*

a. In this case and as noted above in the section title ‘35 U.S.C. 112 2<sup>nd</sup> Paragraph,’ the corresponding structure is not clearly linked in the written description with the required specificity. Therefore, a 35 U.S.C. 112 2<sup>nd</sup> paragraph rejection results. “If the language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement, a rejection of the claim under 35 U.S.C. 112, second paragraph would be appropriate.”

MPEP §2173.02 citing *Morton Int'l, Inc. v. Cardinal Chem. Co.*, 5 F.3d 1464, 1470, 28 USPQ2d 1190, 1195 (Fed. Cir. 1993). For example, the corresponding structure could be a hard drive, computer memory, simply just software, or some other structure. Because of this ambiguity, it is Examiner's factual determination that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement.

b. Examiner will next apply the above reasoning to all claimed phrases that potentially invoke 35 U.S.C. 112 6<sup>th</sup> paragraph. Citations and authorities will be omitted for clarity.

78. It is Examiner's position that Means Phrase #1 and all subsequent means phrases have been considered including the entire specification, including claims and drawings.

### **Combo Means Phrase #2**

79. It is Examiner's position that in claim 1, the “limiting means for storing” and “limiting means ... for referencing” (“Means for Phrase #2”) invokes 35 U.S.C. 112 6<sup>th</sup> paragraph.

a. Means for Phrase #2 meets Invocation Step 1 because “means for” is recited.

b. Means for Phrase #2 meets Invocation Step 2 because the phrase recites the function of “for storing the contents...” and “for referencing the contents.” This function will have its ordinary and plain meaning.

c. Means for Phrase #2 meets Invocation Step 3 because the claim does not recite sufficient definite structure for performing the function of “storing the contents...” and “referencing the contents.”

d. The specification fails to directly disclose what structural elements make up Means Phrase #2. In other words, the corresponding structure is not clearly linked in the written description with the required specificity.

### **Means Phrase #3**

80. It is Examiner's position that in claim 8, the “controlling means for storing” ("Means for Phrase #3") invokes 35 U.S.C. 112 6<sup>th</sup> paragraph.

- a. Means for Phrase #3 meets Invocation Step 1 because “means for” is recited.
- b. Means for Phrase #3 meets Invocation Step 2 because the phrase recites the function of “for storing the contents...” This function will have its ordinary and plain meaning.
- c. Means for Phrase #3 meets Invocation Step 3 because the claim does not recite sufficient definite structure for performing the function of “storing the contents...”
- d. The specification fails to directly disclose what structural elements make up Means Phrase #3. In other words, the corresponding structure is not clearly linked in the written description with the required specificity.

#### **Means Phrase #4**

81. It is Examiner's position that in claims 7 and 8, the “receiving means for receiving” ("Means for Phrase #4") invokes 35 U.S.C. 112 6<sup>th</sup> paragraph.

- a. Means for Phrase #4 meets Invocation Step 1 because “means for” is recited.
- b. Means for Phrase #4 meets Invocation Step 2 because the phrase recites the function of “for receiving the use-permitting key information...” This function will have its ordinary and plain meaning.
- c. Means for Phrase #4 meets Invocation Step 3 because the claim does not recite sufficient definite structure for performing the function of “receiving the use-permitting key information...”

- d. The specification fails to directly disclose what structural elements make up Means Phrase #4. In other words, the corresponding structure is not clearly linked in the written description with the required specificity.

### **Means Phrase #5**

82. It is Examiner's position that in claim 8, the “transmitting means for transmitting” (“Means for Phrase #5”) invokes 35 U.S.C. 112 6<sup>th</sup> paragraph.

- a. Means for Phrase #5 meets Invocation Step 1 because “means for” is recited.
- b. Means for Phrase #5 meets Invocation Step 2 because the phrase recites the function of “for transmitting apparatus identifying information...” This function will have its ordinary and plain meaning.
- c. Means for Phrase #5 meets Invocation Step 3 because the claim does not recite sufficient definite structure for performing the function of “transmitting apparatus identifying information...”
- d. The specification fails to directly disclose what structural elements make up Means Phrase #5. In other words, the corresponding structure is not clearly linked in the written description with the required specificity.

### ***Conclusion***

83. Examiner's Note: Examiner has pointed out particular references contained in the prior art of record within the body of this action for the *convenience* of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific

limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by Examiner.

83. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

- a. U.S. Patent No. 5,665,956 to La et al. discloses a bar code reader.
- b. U.S. Publication No. 2002/0087489 to Iizuka is an English publication of one of the patents in Applicant's information disclosure statement.

84. Any inquiry concerning this communication or earlier communications from Examiner should be directed to C. Aaron McIntyre whose telephone number is (571) 270-5401. Examiner can normally be reached on Monday to Thursday 9-6 ET.

85. If attempts to reach Examiner by telephone are unsuccessful, Examiner's supervisor, Andrew J. Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

86. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. A. M./  
Examiner, Art Unit 3621  
November 14, 2008

/Calvin L Hewitt II/  
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